



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,769	06/24/2005	Renaud Beaudegnies	70204	1717

26748 7590 06/15/2009
SYNGENTA CROP PROTECTION, INC.
PATENT AND TRADEMARK DEPARTMENT
410 SWING ROAD
GREENSBORO, NC 27409

EXAMINER	
YOUNG, SHAWQUITA	

ART UNIT	PAPER NUMBER
1626	

NOTIFICATION DATE	DELIVERY MODE
06/15/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

department-gso.patent@syngenta.com

Office Action Summary

Application No.

10/540,769

Applicant(s)

BEAUDEGNIES ET AL.

Examiner

SHAWQUIA YOUNG

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 2-4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Claims 1-7 are currently pending in the instant application. Claims 1 and 5-7 are rejected and claims 2-4 are withdrawn from consideration.

I. *Response to Arguments/Remarks*

Applicants' arguments, filed on February 2, 2009 have overcome the rejection of claims 1-7 under 35 USC 103. The rejection has been withdrawn.

Applicants state that the references listed on the IDS filed on June 2005 were cited in the international stage search report and of record. However, the Examiner wants to point out that if Applicants want these references considered, they have to file copies of the references. Because Applicants have failed to file copies of the references listed on the IDS, the Examiner will not consider the references.

Applicants' elected the species of the compound 1.0301 on page 62 of the specification in response to the restriction requirement. The elected species is not allowable because of 112, first paragraph enablement issues that will be discussed in further detail below. Thus the search will not be extended to read on other species embraced by claim 1. Further, claims 1 and 5-7 read on the elected species and have been examined with respect to the species. Claims 2-4 do not read on the elected species and are withdrawn from consideration.

II. *Rejection(s)*

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 5-7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the compound 3-[2-(methoxy-ethoxymethyl)-6-trifluoromethyl-pyridine-3-carbonyl]-1,5-dimethyl-8-oxa-bicyclo[3.2.1]oct-6-ene-2,4-dione (example P10) or an agronomically acceptable salt or enantiomer or tautomer of said compound does not reasonably provide enablement for a **isomer** of said compound. The specification does not provide sufficient guidance nor does it enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

As stated in the MPEP 2164.01 (a), "There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue."

In *In re Wands*, 8 USPQ2d 1400 (1988), factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have need described. They are:

1. the nature of the invention,
2. the state of the prior art,
3. the predictability or lack thereof in the art,

4. the amount of direction or guidance present,
5. the presence or absence of working examples,
6. the breadth of the claims,
7. the quantity of experimentation needed, and
8. the level of the skill in the art.

In the instant case

The nature of the invention

The nature of the invention is a the compound 3-[2-(methoxy-ethoxymethyl)-6-trifluoromethyl-pyridine-3-carbonyl]-1,5-dimethyl-8-oxa-bicyclo[3.2.1]oct-6-ene-2,4-dione (example P10) or an agronomically acceptable salt or enantiomer or tautomer of said compound. There is no teaching of isomers of the above species in the specification.

The state of the prior art and predictability or lack thereof in the art

It is the state of the prior art that the term "isomer" found in the claims is defined as compounds that have the same molecular formula, but different structures. There are two types of isomers, constitutional isomers and stereoisomers. Constitutional isomers differ in the way the atoms are connected whereas in stereoisomers the atoms are connected in the same way, but differ in the way the atoms are arranged in space. (<http://chemed.chem.purdue.edu/genchme/topicreview/bp/1organic/isomers.html>>).

The amount of direction or guidance present and the presence or absence of working examples

There is no direction or guidance present in the specification or working examples present in the specification that defines or relates to which compounds of the instant invention can form hydrates. The term "isomer" are only mentioned on page 6 of

the specification.

The breadth of the claims

The breadth of the claims is a compound or an addition salt with a pharmaceutically acceptable mineral acid or organic acid or tautomer or hydrate or isomer of said compound represented in claim 1.

The quantity of experimentation needed and the level of the skill in the art

While the level of the skill in the pharmaceutical art is high, the quantity of experimentation needed is undue experimentation. One of skill in the art would need to prepare compounds without any direction as to what compounds would form hydrates or what isomers to perform.

The level of skill in the art is high without showing or guidance as to how to make solvates of a compound of formula (I) it would require undue experimentation to figure out the amount of water, temperatures and reaction times that would provide hydrates or isomers of the above compounds.

To overcome this objection, Applicant should submit an amendment deleting the term "isomer".

III. Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shawquia Young/

Examiner, Art Unit 1626

/Rebecca L Anderson/

Primary Examiner, Art Unit 1626